

REMARKS/ARGUMENTS

Claims 124-126, 129 and 135-138 are pending in this application and stand rejected on various grounds. Rejections to the pending claims are respectfully traversed.

Claim Rejections – 35 U.S.C. §102(f)

Claims 124-126, 129, 135 and 137 are rejected under 35 U.S.C. §102(f) because the Applicant allegedly did not invent the claimed subject matter.

Applicants respectfully traverse and request reconsideration of this rejection since Applicants provide Exhibit A of Dr. Wood's Declaration and their arguments below.

Arguments

Conception is the "formation in the mind of the inventor, of **a definite and permanent idea of the complete and operative invention**, as it is hereafter to be applied in practice."

Hitzeman v. Rutter, 243 F.3d 1345, 58 USPQ2d 1161 (Fed. Cir. 2001) (Emphasis added).

Applicants submit that they were the first to conceive the novel, "complete" DNA sequence encoding PRO1186. Applicants submit that in this instance, the prior art, the Incyte EST 3476792 sequence, only disclosed an incomplete DNA sequence with partial identity to the nucleotide sequence of SEQ ID NO: 370, disclosed and claimed in the present application.

The amendment filed 10 March, 2006 was not entered because they allegedly raised new issues that required further consideration. Applicants resubmit a copy of the Declaration by Dr. William Wood **with Exhibit A** for the Examiner's review and respectfully request entry and consideration of this Declaration and exhibit.

Applicants submit that Incyte did not possess or reduce to practice a "complete" DNA sequence identical to the instantly claimed DNA of SEQ ID NO: 390 encoding for the PRO1186 polypeptide and provide a Declaration by Dr. William Wood, Director and Staff Scientist in the Bioinformatics Department of Genentech, Inc., for support. Dr. Wood explains in his Declaration that while the Incyte EST sequence (EST 3476792) was used for identifying the coding sequence of PRO1186, the Incyte EST sequence did not code for the full-length PRO1186 polypeptide, since it truncated prematurely before the nucleotide encoding for the stop codon. This is evident in Exhibit A, which is an alignment between the Incyte EST 3476792 DNA sequence (upper line

throughout the alignment) and the instant claimed DNA sequence, called DNA56748.init in Exhibit A. Dr. Wood's Declaration explains that, the sequence DNA56748 in Exhibit A, was later designated as DNA60621, for the reasons discussed below and within the Declaration.

From Exhibit A, it can be seen that the Incyte EST sequence would not code for the full-length PRO1186 polypeptide, since it truncated before the nucleotide encoding for the stop codon. Looking at the Incyte EST 3476792 DNA sequence, one would not know whether the sequence is a cDNA or whether it codes for, at least part of a protein. Applicants submit that even if it had been known that the Incyte EST sequence was a coding sequence, which it was not, it would only have encoded for a truncated polypeptide of PRO1186 and not for the full-length polypeptide of PRO1186. In fact, Applicants used their own knowledge of the extracellular domain sequence of PRO1186 (ECD), clustering analysis, extension of DNA sequences and PCR-based cDNA library screening to obtain the full-length nucleic acid sequence encoding for the PRO1186 polypeptide, and designated this novel DNA (*i.e.*, the DNA56748 cluster) as DNA60621 (also see last line of paragraph 6 of Dr. Wood's Declaration. DNA60621 is also referred to as DNA60621-1516 or SEQ ID NO: 370 in the specification and is the sequence shown in Figure 265). Applicants note that the alignment of DNA56748.init with other sequences like 2813596 and 1549832 in Exhibit A are not relevant to this application.

Therefore, contrary to the Examiner's assertion, Incyte did not possess or reduce to practice a "complete" DNA sequence identical to the instantly claimed DNA of SEQ ID NO: 390 encoding for the PRO1186 polypeptide. Further contrary to the Examiner's assertion, one of skill in the art would not have been able to make a polynucleotide comprising the nucleotide sequence of SEQ ID NO: 370 or its encoding amino acid sequence of SEQ ID NO: 371 without first having realized that EST 3476792 was part of a coding sequence, and or without extending the EST 3476792 sequence, an act which would have required additional knowledge about the protein sequence to be used for the DNA extension, like prior knowledge of PRO1186's extracellular domain, for instance. Such knowledge was not disclosed or suggested by the teachings of Incyte (who did not disclose or reduce to practice the encoded polypeptide or the encoding nucleic acid) around the effective filing date of the instant application. Hence, Applicants submit that the instantly claimed subject matter could not have been derived from the

Incyte EST 3476792 sequence alone without significant work by the Applicants which would contribute towards "conception, completion and operation" of the invention.

Therefore, Applicants respectfully submit that the instant invention was not anticipated by the disclosure of the Incyte EST 3476792 sequence and request that this rejection under 35 U.S.C. §102(f) be withdrawn.

Double Patenting Rejection

Claims 124-126, 129, 135-138 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 13-25 of copending U.S. Patent Application Serial No. 10/692,299.

In view of the presentation of a corrected Declaration by Dr. Wood with Exhibit A, Applicants respectfully request that this rejection be reconsidered and be held in abeyance until there is an indication of allowable subject matter in either of these cases.

CONCLUSION

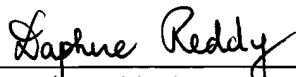
The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (referencing Attorney's Docket No. 39780-2730 P1C65).

Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: April 24, 2006


Daphne Reddy (Reg. No. 53,507)

HELLER EHRMAN, LLP
275 Middlefield Road
Menlo Park, California 94025
Telephone: (650) 324-7000
Facsimile: (650) 324-0638